



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: **Hua, et al.**

Application No.: **10/087,291**

Examiner: **Isaac M. Woo**

Filed: **February 28, 2002**

Docket No.: **LUTZ 2 00079**

Case Name/No. **Hua 14-1**

For: **SEARCHING DIGITAL CABLE CHANNELS BASED ON SPOKEN
KEYWORDS USING A TELEPHONE SYSTEM**

MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF UNDER 37 C.F.R. § 41.37

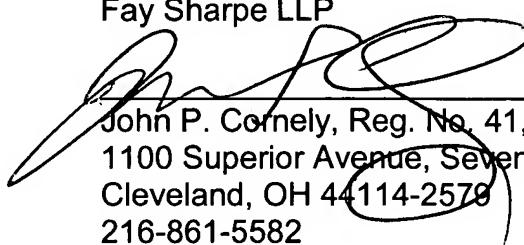
Dear Sir:

Applicant(s) transmit(s) herewith one (1) originally signed copy of the APPEAL BRIEF UNDER 37 C.F.R. § 41.37 for the above-identified patent application.

Payment for the filing of this Appeal Brief and any appropriate extension of time fees are authorized to be charged to a Credit Card. The appropriate PTO form 2038 is enclosed. **If the Credit Card is unable to be charged, please charge any and all fees or credit any overpayment to Deposit Account No. 06-0308.** If there are any additional fees required by this communication, please charge same to Deposit Account No. 06-0308.

Respectfully submitted,

Fay Sharpe LLP



John P. Cornely, Reg. No. 41,687
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

March 12, 2008

Date

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being

deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

transmitted to the USPTO by facsimile in accordance with 37 CFR 1.18 on the date indicated below.

Express Mail Label No.:	Signature: 
Date: March 12, 2008	Name: Iris E. Weber



PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Hua, et al.

Application No.: 10/087,291

Examiner: Isaac M. Woo

Filed: February 28, 2002

Attorney Docket No.: LUTZ 2 00079
Client Case Name/No.: Hua 14-1

For: **SEARCHING DIGITAL CABLE
CHANNELS BASED ON
SPOKEN KEYWORDS USING A
TELEPHONE SYSTEM**

03/18/2008 SDENB0B3 00000035 10087291
02 FC:1402 510.00 OP

BRIEF ON APPEAL

Appeal from Group 2166

John P. Cornely, Esq., Reg. No. 41,687
FAY SHARPE LLP
1100 Superior Avenue – Seventh Floor
Cleveland, Ohio 44114-2579
Telephone: (216) 861-5582
Attorneys for Appellants

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being
 deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop Appeal Brief-Patents,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
 transmitted to the USPTO by facsimile in accordance with 37 CFR 1.18 on the date indicated below.

Express Mail Label No.:

Signature: 

Date: March 12, 2008

Name: Iris E. Weber

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	2
III. STATUS OF CLAIMS	3
IV. STATUS OF AMENDMENTS	4
V. SUMMARY OF CLAIMED SUBJECT MATTER	5
A. <u>Claim 1</u>	5
B. <u>Claim 2</u>	5
C. <u>Claim 11</u>	6
D. <u>Claims 18 and 19</u>	6
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	7
VII. ARGUMENT	8
A. <u>The Rejection of Independent Claims 1 and 11 is Erroneous</u>	8
B. <u>Independent Claim 11 Distinguishes Patentably Over the Prior Art</u>	11
C. <u>Dependent Claims 2 and 19 Further Distinguish Patentably Over the Prior Art</u>	11
VIII. CLAIMS APPENDIX	13
IX. EVIDENCE APPENDIX	16
X. RELATED PROCEEDINGS APPENDIX	17

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Lucent Technologies, Inc., by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 012672, Frame 0414.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-20 are on appeal.

Claims 1-20 are pending.

Claims 1-20 are rejected.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Claim 1

The invention of claim 1 is directed to a method of searching television programming information. The method includes:

[FIGURE 2, step 110; see also page 4, paragraph 0017] receiving a telephone call from a viewer [FIGURE 1, element 10] via a telephone system [FIGURE 1, element 22];

[FIGURE 2, step 130; see also page 4, paragraph 0017] generating a search query in response to the telephone call;

[FIGURE 2, step 140; see also page 4, paragraph 0017] searching a database [FIGURE 1, element 30] in accordance with the search query, said database containing television programming information;

[page 4, paragraphs 0017 and 0018] generating search results from the searching, said search results including entries from the database that correspond to the search query; and,

[FIGURE 2, step 150; see also page 5, paragraph 0019] sending the search results to a television receiver box [FIGURE 1, element 14] of the viewer via a television system [FIGURE 1, element 16] such that said search results are displayable upon a television [FIGURE 1, element 12] operatively connected to the receiver box.

B. Claim 2

Claim 2, which depends from claim 1, recites that the method further includes identifying the viewer from which the telephone call is received via caller ID [see, e.g., FIGURE 2, step 120; see also page 5, paragraph 0020].

C. Claim 11

The invention of claim 11 is directed to a service control point [FIGURE 1, element 24] connected to a telephone system [FIGURE 1, element 22] and a television system [FIGURE 1, element 16]. The service control point includes:

query generating means [FIGURE 1, element 26] for generating a search query in response to a telephone call received from a viewer [FIGURE 1, element 10] via the telephone system;

a database [FIGURE 1, element 30] in which television programming information is maintained; and,

searching means [FIGURE 1, element 28] for searching the database in accordance with the search query received from the query generating means, said searching means generating search results which are sent to a television receiver box [FIGURE 1, element 14] of the viewer via the television system such that said search results are displayable upon a television [FIGURE 1, element 12] operatively connected to the television receiver box.

D. Claims 18 and 19

Claim 18, which depends from claim 11, further recites that the service control point includes identification means for identifying the viewer from which a call is received, and claim 19, which depends from 18, further recites that the identification means comprises caller ID [see, e.g., FIGURE 2, step 120; see also page 5, paragraph 0020].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,314,398 to Junqua, et al. ("Junqua") in view of U.S. Patent No. 6,996,531 to Korall, et al. ("Korall").

VII. ARGUMENT

A. The Rejection of Independent Claims 1 and 11 is Erroneous

Significantly, the claims distinguish patentably over the prior art. That is to say, the references fail to teach each and every claimed feature. Moreover, the rejection is erroneous because there is improper and/or inadequate motivation to combine the references as proposed by the Examiner.

It is widely accepted that the initial burden of establishing a *prima facie* conclusion of obviousness rests with the Examiner. See, e.g., the Manual of Patent Examining Procedure (MPEP) §2142. In the present instance, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, the rejection of the claims is erroneous.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. Significantly, the combination of references in this case fail to teach or suggest all the claim limitations. Moreover, the Examiner provides no suitable motivation for making the proposed combination.

When making a rejection under 35 U.S.C. §103, the Examiner is required to set forth in the Office Action: (i) the proposed modification of the reference necessary to arrive at the claimed subject matter, and (ii) an explanation why one of ordinary skill in

the art at the time the invention was made would have been motivated to make the proposed modification. See MPEP §706.02(j) (C) and (D). The Examiner in the present case sets forth neither of these requirements in the Office Action. Rather, the Examiner merely indicates that it would have been obvious to incorporate the teachings of Korall into the system of Junqua. This merely conclusory statement is without any supporting evidence or rational, and is inadequate to maintain a *prima facie* case of obviousness.

With regard to item (i) above, nowhere does the Office Action indicate with any specificity how Junqua is being modified by Korall. The Office Action merely states that it would have been obvious "to utilize the teaching of Korall to the system of Junqua." This statement in no way describes how Junqua is being modified by Korall.

With regard to item (ii), there is no appropriate motivation for making the combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01(III). Notably, the entire system **10** of Junqua is incorporated into a set-top decoder box **52** or the television **50** itself. See, FIGURE 1 and column 3, lines 10-17. Accordingly, the proposed motivation cited in the Office Action (i.e., "to formulate searchable text query from telephone input for accessing database") simply does not make any sense. One of ordinary skill in the art would not be motivated to access the database **18** via a telephone call insomuch as the database **18** is already present on the TV **50** or set-top box **52** at the user's location.

Additionally, the Examiner provides no suitable support for the obviousness rejection. That is, the motivation for any proposed combination is not expressly recited in the prior art itself, and the Examiner's statements in this regard simply lack any supporting evidence in the record.

Again, the MPEP is instructive on this point. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP §2143.01. Insomuch as neither Junqua nor Korall expressly provides the alleged motivation for making the proposed combination, presumably the Examiner is relying on what is well-known prior art or common knowledge in the art.

In the present case, the Applicant has seasonably challenged the statements by the Examiner that are not supported by evidence on the record. See, e.g., “Amendment C,” filed on or about December 15, 2006. Still, the Examiner has cited no specific references that provide the motivation for the proposed combination. Nevertheless, compliance with MPEP §2144.03 mandates that if an Examiner is to properly maintain a rejection then documentary evidence must be supplied when the Applicant traverses the Examiner’s assertions with respect to what is well-known or common knowledge in the art. Alternately, if the Examiner was unable to provide the required evidence by way of a cited reference, and was instead relying on their own personal knowledge, Applicant has requested that the evidence be provided in the form of an affidavit from the Examiner under 37 C.F.R. §104(d)(2). Again, no such evidence has been provided by the Examiner. Absent substantiation on the record by the Examiner as to the motivation to make the alleged combination, the rejection under 35 U.S.C. §103(a) is erroneous.

Finally, according to MPEP §2141(a), for a reference to be relied upon under 35 U.S.C. §103, it must be analogous art. In the present case, Korall is non-analogous art. Importantly, Junqua is directed to an interactive television channel selection apparatus

and method. Korall, on the other hand, is directed to an automated directory assistance system, e.g., for obtaining telephone numbers and/or other directory assistance information.

B. *Independent Claim 11 Distinguishes Patentably Over the Prior Art*

Notwithstanding the inappropriateness of the combination, Junqua in view of Korall still fails to teach all the claimed features. Accordingly, the claims distinguish patentably over the prior art. More specifically, e.g., claim 11 is directed to a service control point connected to a telephone system and a television system. Neither Junqua nor Korall disclose such a service control point.

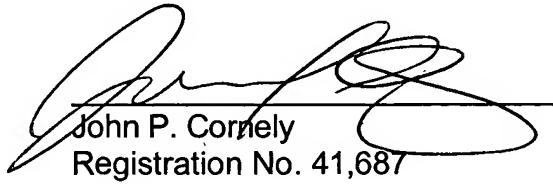
C. *Dependent Claims 2 and 19 Further Distinguish Patentably Over the Prior Art*

Additionally, claim 2 calls for "identifying the viewer from which the telephone call is received via caller ID." Claim 18 recites identification means for identifying the viewer from which a call is received, and claim 19 calls for the identification means to comprise caller ID. The Office Action concedes that Junqua fails to disclose the foregoing. However, the Office Action erroneous alleges that Korall does disclose the foregoing. In support of this position, the Office Action references col. 9, line 65 through col. 10, line 3. However, the cited passage is not referring to caller ID or even identifying the user. Rather, Korall is referring to a reverse directory look-up where a user enters a telephone number and the output is the name of the subscriber associated with that telephone number. This is not the same as caller ID and it does not identify the individual calling directory assistance to perform the search.

CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejection(s) are in error and that claims 1-20 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejection(s) of claims 1-20.

Respectfully submitted,



John P. Cornely
Registration No. 41,687

:iew

FAY SHARPE LLP
1100 Superior Avenue – Seventh Floor
Cleveland, Ohio 44114-2579
Telephone: (216) 861-5582

Filed: March 12, 2008

APPENDICES

VIII. CLAIMS APPENDIX

Claims involved in the Appeal are as follows:

1. (Original) A method of searching television programming information comprising:

- (a) receiving a telephone call from a viewer via a telephone system;
- (b) generating a search query in response to the telephone call;
- (c) searching a database in accordance with the search query, said database containing television programming information;
- (d) generating search results from the searching, said search results including entries from the database that correspond to the search query; and,
- (e) sending the search results to a television receiver box of the viewer via a television system such that said search results are displayable upon a television operatively connected to the receiver box.

2. (Original) The method according to claim 1, further comprising: identifying the viewer from which the telephone call is received via caller ID.

3. (Original) The method according to claim 1, wherein the search query is at least partially generated from spoken language from the viewer which is received via the telephone system and input into a voice recognition module.

4. (Original) The method according to claim 1, wherein only current television programming information is maintained in the database.

5. (Original) The method according to claim 1, wherein current television programming information and a period of future television programming information are maintained in the database.

6. (Original) The method according to claim 1, further comprising: deactivating the search results after the telephone call has terminated such that they are no longer displayable on the television.
7. (Original) The method according to claim 1, further comprising: announcing a summary of the search results to the viewer via the telephone system.
8. (Original) The method according to claim 1, wherein the search results include a list of channels showing programs which match the search query.
9. (Original) The method according to claim 8, wherein the viewer can selectively scroll through the list of channels.
10. (Original) The method according to claim 8, wherein the viewer can select a channel from the list of channels to view information about the program being shown on that channel.
11. (Original) A service control point connected to a telephone system and a television system, said service control point comprising:
 - query generating means for generating a search query in response to a telephone call received from a viewer via the telephone system;
 - a database in which television programming information is maintained; and,
 - searching means for searching the database in accordance with the search query received from the query generating means, said searching means generating search results which are sent to a television receiver box of the viewer via the television system such that said search results are displayable upon a television operatively connected to the television receiver box.

12. (Original) The service control point of claim 11, wherein the query generating means includes a voice recognition module that receives spoken language from the viewer and converts it into at least a portion of the search query.

13. (Original) The service control point of claim 11, wherein only current television programming information is maintained in the database.

14. (Original) The service control point of claim 11, wherein current television programming information and a period of future television programming information are maintained in the database.

15. (Original) The service control point of claim 11, wherein the television system is selected from a group consisting of a digital cable television system, an analog cable television system, and a satellite television system.

16. (Original) The service control point of claim 11, wherein the television programming information includes abstractions of program content.

17. (Original) The service control point of claim 11, wherein the database includes a searchable field containing identification of program types.

18. (Original) The service control point of claim 11, further comprising: identification means for identifying the viewer from which a call is received.

19. (Original) The service control point of claim 18, wherein the identification means comprises caller ID.

20. (Original) The service control point of claim 11, wherein the search results include a list of channels showing programs which match the search query.

IX. EVIDENCE APPENDIX

Appellant, Appellant's representative, and/or the Assignee are aware of no evidence submitted under 37 CFR §§1.130, 1.1331, or 1.132 or of any other evidence entered by the Examiner and relied upon by the Appellant in the present appeal. Accordingly, the remainder of this page has been intentionally left blank.

X. RELATED PROCEEDINGS APPENDIX

Appellant, Appellant's representative, and/or the Assignee are aware of no related proceeding in connection with this matter. Accordingly, the remainder of this page has been intentionally left blank.